

REMARKS

Claims 1-64 are pending in the Application. Claims 57-64 are allowed and claims 1-56 stand rejected. Claims 1, 18, 25, 33, 39, 48 and 49 have been amended. Claims 65-70 have been added. Applicant respectfully requests reconsideration and favorable action in this case.

Interview Summary

The undersigned representative thanks the Examiner for the courtesy of the telephonic interview held on January 7, 2009.

The substance of the interview included a discussion of claims 1, 18, 25, 33, 39, 48, and 49 and the rejections of record under 35 U.S.C. § 101. During the interview, the Examiner agreed, subject to an updated search, that claims 1-52 are allowable as currently amended.

Section 101 Rejections

The Office Action rejects claims 1-56 as allegedly not falling within one of the four statutory categories of invention under 35 U.S.C. § 101. Applicant respectfully traverses this rejection because the claims are directed to statutory subject matter.

That said, in order to advance prosecution, Applicant has amended the preamble of independent claims 1, 18, 33, 39, and 48 to recite “A computer-implemented method . . .” in an effort to address the concerns of the Examiner. This amendment explicitly demonstrates that the claims are “tied to another statutory class (such as a particular apparatus)” because the method is implemented on a computer, which is a particular apparatus. Similarly, Applicant has amended claims 25 and 49 to recite “An article comprising a computer-readable medium . . .” to address the concerns of the Examiner.

Citing a May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, entitled Clarification of “Processes” under 35 U.S.C. 101 (the “May 18 memorandum”), the Office Action states that “[w]hile the claims recite a series of steps or acts to be performed, a statutory ‘process’ under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing.” The Office Action rejects the claims

because they allegedly fail to transform underlying subject matter or positively tie to another statutory category that accomplishes the claimed method steps. The Office Action cites no further reasoning for the rejection.

Claims 1-24 and 33-48, which are method claims, are directed to “transform[ing] underlying subject matter (such as an article or material) to a different state or thing,” specifically to transforming images. Images are capable of being displayed and perceived visually in the physical world. *Cf., e.g., In Re Bilski*, 545 F.3d 943, 963 (Fed. Cir. 2008) (“We further note for clarity that the electronic transformation of the data itself into a visual depiction in *Abele* was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented.”). Claims 25-52 and 49-56 involve similar subject matter. Because the claims here are directed to transforming images, they satisfy the second prong (i.e., the transformation prong) of the test proffered in the May 18 memorandum, and are thus directed to a statutory “process” under § 101.

Moreover, the May 18 memorandum is directed to whether a claimed method is a “process” under § 101, and does not address articles of manufacture. Claims 25-32 and 49-56, which are all claims for articles of manufacture, were purportedly rejected based on the May 18 memorandum. This rejection, however, is improper because the memorandum has no bearing on claims for articles of manufacture, which are statutory subject matter under § 101. *See* MPEP 2106.01, I (“In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.”). Accordingly, Applicant respectfully requests allowance of claims 25-32 and 49-56.

CONCLUSION

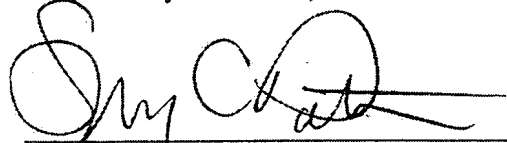
Applicant has made an earnest attempt to place this case in condition for allowance. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

Additional claims fees in the amount of \$312.00 (\$52.00 X 6) are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account No. 06-1050 authorization. The Commissioner is hereby authorized to charge any other deficiencies or required fees or any credits to Deposit Account No. 06-1050 referencing the attorney docket number shown above.

Date: January 8, 2009

Respectfully submitted,



Spencer C. Patterson
Reg. No. 43,849

Fish & Richardson P.C.
1717 Main Street
Suite 5000
Dallas, TX 75201
Telephone: (214) 747-5070
Facsimile: (214) 747-2091